

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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APR 14 2005

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BRIAN E. SPRINGETT and DONALD G. MONEFELDT

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Appeal No. 2005-0620  
Application 10/010,202

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ON BRIEF

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Before THOMAS, HAIRSTON and OWENS, *Administrative Patent Judges*.  
OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This appeal is from a rejection of claims 1, 2, 4-6  
and 8-10.

*THE INVENTION*

The appellants claim a transfer sheet having, on a carrier sheet, a colored pattern layer and, thereover, a layer of white

colored material, both layers being formed using a digitally controlled color printer. Claim 1 is illustrative:

1. A transfer sheet, including:

a carrier sheet;

a colored pattern printed on a surface of said carrier sheet using at least one digitally controlled color printer; and

a layer of white colored material printed over at least the colored pattern using the digitally controlled color printer.

*THE REFERENCE*

Franke  
(PCT application)

WO 97/21867

Jun. 19, 1997

*THE REJECTION*

Claims 1, 2, 4-6 and 8-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Franke.

*OPINION*

We affirm the aforementioned rejection.

The appellants state that the claims do not stand or fall together (brief, page 5). The appellants, however, merely set forth the content of the claims and where support therefor is found in the specification (brief, pages 6-8). The appellants do not separately argue the patentability of the inventions in the claims. We therefore limit our discussion to one claim, i.e., claim 1. See *In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d

1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c)(7)(1997).

Franke discloses a transfer sheet comprising a carrier sheet, a one- or multi-colored pattern printed on the carrier sheet using a digitally controlled color printer, and a white-pigmented elastomer layer of a polymer having a high plasticizing point printed configuratively on the pattern (page 3, lines 28-36). The only method Franke discloses for applying the white-pigmented elastomer layer is screen printing (page 12, lines 3-7; page 17, lines 34-35).

The digitally controlled color printers disclosed in the appellants' specification are an electrophotographic printer and an ink jet printer (page 1, lines 18-20; page 18, lines 10-17). Franke discloses that in addition to a polyurethane component of the white pigmented elastomer layer, other thermoplastic resins may be used (page 15, lines 6-11). Thermoplastic resins are the type of material applied using an electrophotographic printer.<sup>1</sup> Franke also discloses that the white pigmented elastomer layer can be applied from an organic or aqueous solution, which is the

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<sup>1</sup> See 8 *Kirk-Othmer Encyclopedia of Chemical Technology* 796 (John Wiley & Sons, 3<sup>rd</sup> ed. 1979), a copy of which is provided to the appellants with this decision.

type of material applied by an ink jet printer.<sup>2</sup> Because, in forming his white pigmented elastomer layer, Franke applies the types of materials applied using the appellants' digitally controlled color printer, it reasonably appears that Franke's white colored layer is the same or substantially the same as that recited in the appellants' product-by-process claim 1. Moreover, the disclosure in the appellants' specification that "[f]urther details of the various types of materials that may be employed are described in International Publication No. WO 97/21867, published June 19, 1997 [which is the Franke reference], the relevant portions thereof being hereby incorporated into the present application" (page 17, line 27 - page 18, line 3), indicates that the materials used by the appellants are the same as those used by Franke.

The appellants argue that "[s]ince product-by-process claims are limited by and defined by the process, it therefore logically follows that Franke may **not** properly be cited as a 35 USC §102 reference against Applicants' claims, **if** the claims presently before the Examiner disclose a process limitation **not** disclosed

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<sup>2</sup> See 20 *Kirk-Othmer Encyclopedia of Chemical Technology* 155-56 (John Wiley & Sons, 3<sup>rd</sup> ed. 1982), a copy of which is provided to the appellants with this decision.

in Franke" (brief, page 10). The appellants are incorrect. The patentability of an invention claimed as a product-by-process is determined based on the product itself, not on the method of making it. See *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) ("If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process."). Whether a rejection is under 35 U.S.C. § 102 or § 103, when the appellants' product and that of the prior art appear to be identical or substantially identical, the burden shifts to the appellants to provide evidence that the prior art product does not necessarily or inherently possess the relied-upon characteristics of the appellants' claimed product. See *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); *In re Fessmann*, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. See *Best*, 562 F.2d at 1255, 195 USPQ at 434; *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

The appellants argue that *Thorpe* is inapplicable because the appellants have argued that the appellants' product and that of Franke are different (reply brief, page 2). As pointed out above, evidence that the products are different is required, and the appellants have not provided such evidence.

The appellants argue that their specification provides evidence of an unobvious difference between the claimed product and prior art products (reply brief, page 3). The specification incorporates Franke by reference and states that Franke provides further details of the various materials that can be used in making the appellants' product (page 17, line 28 - page 18, line 3), but the specification does not provide evidence that the appellants' claimed product differs from that of Franke.

The appellants quote (brief, page 10) the Federal Circuit as stating in *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845, 23 USPQ2d 1481, 1490 (Fed. Cir. 1992), that

the rule is well established that where one has produced an article in which invention rests over prior art articles, and where it is not possible to define the characteristics which make it inventive except by referring to the process by which the article is made, he is permitted to so claim his article, but is limited in his protection to articles produced by his method referred to in the claims.

Appeal No. 2005-0620  
Application 10/010,202

Actually, the Federal Circuit was citing, in a long discussion of prior product-by-process cases, a 1941 CCPA case, *In re Moeller*, 117 F.2d 565, 568, 48 USPQ 542, 545 (CCPA 1941), wherein the CCPA stated: "We think the rule is well established ...." The court in *Atlantic Thermoplastics* stated that

accommodating the demands of the administrative process and recognizing the capabilities of the trial courts, this court treats claims differently for patentability as opposed to validity and infringement. The PTO's treatment of product-by-process claims as a product claim for patentability is consistent with policies giving claims their broadest reasonable interpretation. The same rule, however, does not apply in validity and infringement litigation.

*Atlantic Thermoplastics*, 970 F.2d at 846, 23 USPQ2d at 1491.

We therefore find that the transfer sheet claimed in the appellants' claim 1 is anticipated by Franke. Accordingly, we affirm the rejection of that claim and claims 2, 4-6 and 8-10 that stand or fall therewith.


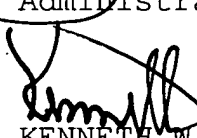
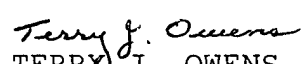
#### DECISION

The rejection of claims 1, 2, 4-6 and 8-10 under 35 U.S.C. § 102(b) over Franke is affirmed.

Appeal No. 2005-0620  
Application 10/010,202

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

*AFFIRMED*

	)	
JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
KENNETH W. HAIRSTON	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
TERRY J. OWENS	)	
Administrative Patent Judge	)	

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Appeal No. 2005-0620  
Application 10/010,202

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